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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/731,919

12/09/2003

W. Daniel Hillis

APPL0015C

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EXAMINER

CHAN, WING F

ART UNIT

PAPER NUMBER

2643

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/731,919	Applicant(s) HILLIS ET AL.	
	Examiner Wing F. Chan	Art Unit 2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 5-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U. S. Patent No. 6,714,234. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are broader versions of patent claims 1-18, and the dependent claims are also obvious over the patent claims since the patent claims is in comprising format it is open to cover the other non claimed features.

As can be seen from a comparison of applicant's claim 1 and patent claim 1, the preamble of claim 1 recited, "synthesizing a final image of an object" while patent claim 1 calls for "providing eye contact in a video conference", and the body of the claim replaces "participant" with 'object'.

As set forth in In re Vogel 164 USPQ 619, the specification can be used as a dictionary to learn the meaning of terms used in the patent claims. Since the present application is a continuation of U. S. Patent No. 6,714,234, the patent disclosure and the present application both clearly describes the functions and limitations, which are encompassed by the claim's comprising format. The 234 patent in col. 3, line 65 to col. 4 line 10 for example, reference is made to illuminating a participant using a structured light pattern, in view of this definition of the patentee, the participant is the object as stated in the present claims, while the other structures are also disclosed. Therefore, the structures of patent claim 1 are recited in a broader form as in present claim 1 is deemed obvious over patent claim 1 since the functions are clearly set forth in the specification to be the same as that of patent claim 1.

In view of the above analysis applicant's claim 1 and patent claim 1 are not patentably distinct from one another and in the absence of a terminal disclaimer would result in possible harassment by multiple assignees.

The above analysis also applies to claim 13 in a manner similar to claim 1 above. Hence, applicant's claim 13 and patent claim 10 are not patentably distinct from one another and in the absence of a terminal disclaimer would result in possible harassment by multiple assignees.

The dependent claims are also the same as those of patent 6,714,234 therefore are not patentably distinct from one another and in the absence of a terminal disclaimer would result in possible harassment by multiple assignees.

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3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitations as set forth in claims 2 ("restorative warping"), 3 ("is a fraction of said restorative warping, wherein said fraction can be any of: positive, negative, zero, greater than one, and less than one"), 4 ("said fraction is a quotient of a distance from said second position to a point characterizing said desired perspective and a distance from said second position to said first position") are nowhere to be found within the specification, therefore the specification is inadequately written to provide support for these claims. Furthermore, since the specification fails to provide any description thereof for claims 2-4, the specification is therefore non-enabling with respect to these claims also.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Examiner W. F. Chan** whose telephone number is 703-305-4732.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached at 703-305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-305-3900.

A handwritten signature in black ink, appearing to read 'Wing F. Chan', is positioned above the printed name.

WING F. CHAN
SENIOR PRIMARY EXAMINER
TECHNOLOGY CENTER 2600

WFC
9/28/04